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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,178	10/16/2001	Gene Stellan	2334 DIV	5414

7590 03/03/2004

United States Surgical, a division of  
TYCO HEALTHCARE GROUP LP  
150 Glover Avenue  
Norwalk, CT 06856

EXAMINER

DESANTO, MATTHEW F

ART UNIT	PAPER NUMBER
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3763

15

DATE MAILED: 03/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/981,178

Applicant(s)

STELLON ET AL.

Examiner

Matthew F DeSanto

Art Unit

3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 2-19, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Danks et al. (USPN 5868773).

Danks et al. discloses a cannula (13), an obturator assembly (12), an obturator housing (distal end of Figure 3B), a penetrating tip (81), an elongated shield (15), a guard (51), a latch mechanism (33), a blocking surface (25), a mating surface (28), a release member with a button surface (22) and a camming surface (29) and a flat knife blade. (Figures 2A, 3A-3C, Figures 6A-6D and entire reference)

3. Claims 2-19 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Schwemberger et al. (5904699).

Schwemberger et al. discloses a cannula (40), an obturator assembly, a housing (51), a penetrating tip (61), an elongated shield, a guard (56), a latch mechanism including a release member (52), and a latch operatively associated with the release member. (Figures 1-15, Column 11, lines 21-35 [with regards to the method claims and the movement of the guard with respect to applied force] and entire reference)

4. Claims 2-10, 11-13, and 14-19, 21 is rejected under 35 U.S.C. 102(b) as being anticipated by Holmes et al. (USPN 4,931,042).

Holmes et al. discloses a trocar assembly with a cannula assembly with a release member (26b) with a camming surface that imparts lateral movement of a blocking surface on a latch (40), which permits movement of a shield (26) and a penetrating tip (24). (Figures 1, 2, Column 4, lines 46-52, and entire reference)

5. Claims 2-10, 11-13, and 14-19, 21 is rejected under 35 U.S.C. 102(b) as being anticipated by Smith et al. (USPN 5,387,197).

Smith et al. discloses a trocar assembly with a cannula assembly with a release member (270,230) with a camming surface that imparts lateral movement of a blocking surface on a latch (250), which permits movement of a shield and a penetrating tip. (Figures 1, 4, 4A, 5, Column 11, lines 8-33 and entire reference)

### ***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 2-10, and 14-21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1-9 of U.S. Patent No. 6,319,266. Although the conflicting claims are not identical, they are not patentably

distinct from each other because the above mentioned patent are substantially similar to the claims in the instant application because they both claim the same structural limitations such as a cannula, an obturator assembly, a housing, a penetrating tip, an elongated shield, a guard, a latch mechanism, a blocking surface, a mating surface, and a flat knife blade.

***Allowable Subject Matter***

8. Claim 20 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

9. Applicant's arguments filed 12/2/03 have been fully considered but they are not persuasive.

The examiner shows the reference numbers and page number of the claimed language that the applicant argues. Please see above rejections.


The applicant mentions that a terminal disclaimer was filed, but there is no record of this in the case. Therefore, the examiner is keeping the double patenting rejection.

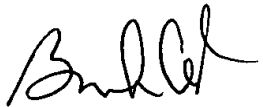
***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew F DeSanto whose telephone number is 1-703-305-3292. The examiner can normally be reached on Monday-Friday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 1-703-308-3552. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Matthew DeSanto  
Art Unit 3763  
February 21, 2004

  
BRIAN L. CASLER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700